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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2625

Fumio TOKUTOMI, et al.

SERIAL NO: 09/925,737

EXAMINER: Qin, Yixing

FILED: August 10, 2001

FOR: PRINT APPARATUS CONSUMABLE PURCHASE SYSTEM AND
PROGRAM USED WITH THE SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

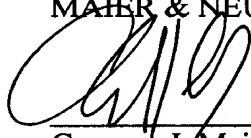
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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REMARKS/ARGUMENTS

I. Background

Claims 3, 7, 8, 11, 13, 15, 18, 20, 23, 26, 29, 32, and 34-38 are presently active in this case. Claim 3 is in independent form, and all of the other claims depend, either directly or indirectly, from claim 3.

Independent claim 3 defines a print apparatus consumable purchase system for facilitating the purchase of a consumable used in a print apparatus when that consumable is either exhausted or low. The consumable may be, for instance, a cartridge of coloring material. The overall purchase system defined by independent claim 3 comprises:

- (1) a printer for printing on a print medium (such as paper);
- (2) a display capable of displaying information concerning the print apparatus (such as the amount of the consumable remaining); and
- (3) a controller (either within or independent of the print apparatus) for displaying information concerning the print apparatus on the display. That information includes the “consumption degree” (i.e., the amount, perhaps expressed as a percentage) of the consumable that has been consumed. The controller also causes the display to display one of a plurality of options concerning replenishment of the consumable **and** an option calling button for calling the plurality of options to the status screen. Notably, the plurality of options includes **both** a delivery purchase option represented by a corresponding delivery purchase button **and** an in-store purchase and pick-up option represented by a corresponding in-store purchasing and pick-up button. The in-store purchase and pick-up button causes the display to provide dealer information and to permit the user to reserve a desired amount of the consumable for an in-store purchase from a selected dealer.

II. The Rejection

Independent claim 3 was rejected under 35 USC 103 as unpatentable over Hayward in view of Vallabh.

III. Clear Error in the Office Action

Applicants believe that the office action clearly errs in extrapolating from what is actually shown by the references to what applicants are claiming. That is, the office action

concedes that the references do not disclose what applicants are claiming, but it rejects independent claim 3 anyway.

Specifically, the second paragraph of the section of the office action entitled **Response to Arguments** begins “Although the references do not explicitly disclose the above amendment [i.e., the subject matter added to independent claim 3 by the previous amendment]....” It then goes on to simply assert that “the representation of a particular option as a button is well-known.” That’s true enough in a broad, general sense—but independent claim 3 doesn’t simply recite the representation of an option as a button. It recites the representation of a particular, specified option in a particular specified system as a button.

Similarly, the third paragraph of that section of the office action asserts that “even though the Vallabh reference discloses the use of electronic payment [i.e., something other than what is recited in independent claim 3],” what is actually recited in independent claim 3 would have been obvious.

The third paragraph of that section continues by asserting that “the option simply could be a preference of the buyer.” However, not everything that a buyer would prefer to have would have been obvious--both in the sense that the buyer might not realize that that was his or her preference until the seller convinces him or her of that and in the sense that how to satisfy that preference might not have been obvious.

Next, turning to the fourth paragraph of that section, applicants submit that the office action simply misreads independent claim 3. Applicants are well aware that the PTO is entitled to give claims their broadest reasonable interpretation. However, the PTO’s interpretation must be **reasonable**. In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Here, the office action reads the claim language which recites reserving an item at a dealer that has that item prior to going to the store to purchase that item as responding to

Vallabh's disclosure of paying for the item at the store. Of course, by the time that one has picked up an item on a store shelf and taken it to a cashier, one is not reserving the item. One is simply buying the item.

Finally, the office action simply asserts that, "Since both the addition of different buttons and the usage of a commonplace buying option has been known, it would have been obvious to one of ordinary skill in the art at the time of [the] invention to have implemented these additions to the Hayward/Vallabh invention." What an ipse dixit!¹ The PTO might as well assert that, since all of the elements are known, all compounds comprising combinations of those "old elements" would have been obvious to one of ordinary skill in the art at the time of all applicants' inventions!

IV. Request

In view of the foregoing, applicants request a finding this their active claims are allowable.

¹ According to my dictionary, an "ipse dixit" is "an assertion made but not proved." More colloquially, an "ipse dixit" is an assertion that something is true because the speaker says that it is true.